REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-9 and 11-36 were originally pending. Claim 31 was amended to incorporate the already examined features of canceled claim 32. Claims 17-24 and 32 were canceled without prejudice. Accordingly, claims 1-9, 11-16, 25-31, and 33-36 remain pending

35 USC §112, Second Paragraph, Rejections

Claims 1, 3, 4, 8, 11, 12, 18, 19, 20, 35 and 36 stand rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant appreciated the opportunity to discuss these claim rejections with the Examiner during the telephone interview on January 20, 2006. During that conversation, and as indicated in the current Action, it was clarified that the claims do particularly point out and distinctly claim the subject matter of the invention. Specifically, Applicant agrees with the Examiner's interpretation that "the portion" is referencing "a portion", "the segment" is referencing "a segment", "the other portion" is referencing "another portion", and "another segment" is referenced by "the other segment".

Withdrawal of the 35 USC §112, second paragraph, rejection is requested.

35 USC §102(e) Rejections

Claims 1-6, 16-21, 24, 25, 29, 31 and 32 stand rejected under 35 USC 102(e) as being anticipated by US patent number 5,956,405 to Yuval. These rejections are traversed.

Claim 1 recites:

- selecting a portion of a digital good;

- selecting another portion of the digital good, wherein the other portion is to be encrypted; and

- using the portion as a substitution box (S-box) when encrypting the other portion.

The Action asserts that these features of claim 1 are anticipated by the description of Yuval at column 14, lines 5-19. Applicant respectfully disagrees. This cited portion of Yuval is claim language describing that a block of application code is used as a substitution block that is subsequently used to encrypt "a set of bits". Significantly, this claim language of Yuval, when interpreted in light of the specification of Yuval (please see column 5, line 60 through column 11, line 35) clearly indicates that **the "set of bits" that is being encrypted with the substitution block of Yuval is not part of the application code from which the substitution block was derived.** Instead, the set of bits being encrypted with the substitution block are bits associated with a message (i.e., a message address header and a message payload) that is completely independent from the application code that was used to create the substitution block.

Specifically, Yuval at column 5, line 65 through column 6, line 25, describes that a block of application code 234 that is suitable for use as an S-box is selected. Yuval makes this selection such that the S-box is selected from blocks of application code that are common across a controller and control devices, when appropriate. At column 6, line 64 through column 7, line 10, Yuval describes that a user selects a 8-byte cipher text code, which "may be thought of as a commonly shared 'secret' used by the devices in a particular home control system as part of the message authentication process." Next, Yuval begins describing operations to generate an encrypted message 400 (column 7 lines 66 and 67). At column 8, lines 8-49, Yuval describes generating a message header 536 and an encrypted message payload 542.

At column 9, lines 3-42, Yuval describes that an 8-byte cipher key is generated from the message header and the encrypted message payload. Yuval describes that a series of substitution operations using the substitution box (S-box 234) and the 8-byte cipher key are then performed to generate a modified 8 bytes of cipher text. Clearly, **this explicit disclosure of Yuval describes that the S-box created from a portion of application code is used to encrypt cipher text that is generated from a message header and payload**. Thus, Yuval does not describe that the substitution box generated from the application code is subsequently used to encrypt another portion of the application code. Thus, Yuval does not anticipate "selecting a portion of a digital good", "selecting another portion of the digital good, wherein the other portion is to be encrypted", and "using the portion as a substitution box (S-box) when encrypting the other portion", as claim 1 requires.

Withdrawal of the 35 USC §102(e) rejection of claim 1 is requested.

Claims 2-6 depend from claim 1. Thus, claims 2-6 are not anticipated by Yuval at least for reasons based on this dependency on claim 1.

Withdrawal of the 35 USC §102(e) rejections of claims 2-6 is requested.

Additionally, claims 2-6 include further features that are not anticipated by Yuval.

For example, <u>claim 2</u> recites: "wherein the entire digital good is to be encrypted". In addressing this feature, the Action asserts that Yuval at column 5, line 60 through column 6, line 12, and Fig. 3, item 310, describe this feature. For the reasons discussed above with respect to claim 1, these cited portions of Yuval do not describe "wherein the entire digital good is to be encrypted", as claim 2 requires. This is because, although Yuval may generate a substitution box from a portion of application code, that substitution box is not used to encrypt any other portion of the application code. Instead, the substitution box is used to encrypt a message that is completely separate and independent of the application code from which the substitution box was derived.

For these additional reasons, Yuval does not anticipate claim 2.

Claim 16 depends on claim 8 and is not anticipated by Yuval solely by virtue of this dependency. Claim 8 recites:

- selecting a segment of a digital good;

- selecting another segment of the digital good, wherein the other segment is to be encrypted using an encryption process; and

- mapping, as at least part of the encryption process, values within the other segment to new values based on the segment, wherein the mapping comprises using the segment as a substitution box (S-box) during the encryption process

For the reasons are discussed above respect to claim 1, Yuval does not anticipate these features of claim 8. As a result, Yuval cannot anticipate the features of claim 16, which depend from claim 8.

Withdrawal of the 35 USC §102(e) rejection of claim 16 is requested.

Claim 25 recites:

- a production server equipped with a substitution box (S-box) protection tool that is used to augment the original program for protection purposes, the production server being configured to identify a first segment in the original program and use the first segment as an S-box when encrypting a second segment of the original program.

For the reasons are discussed above respect to claim 1, Yuval does not anticipate these features of claim 25. .

Withdrawal of the 35 USC §102(e) rejection of claim 25 is requested.

Claim 29 depends from claim 25, which for the reasons discussed above is not anticipated by Yuval. Accordingly, claim 29 is patentably distinguished from Yuval at least based on this dependency on claim 25.

Withdrawal of the 35 USC §102(e) rejection of claim 29 is requested.

Claim 31 recites:

- a production server to use a portion of a first digital good as a substitution box (S-box) in encrypting at least a portion of a second digital good to produce a protected digital good;

- a client to store and execute the protected digital good, the client being configured to evaluate the protected digital good to determine whether the protected digital good has been tampered with; and

- wherein the first digital good and the second digital good are the same digital good.

Claims 7, 8, 9, 11-15, 22, 23, 30 and 34 stand rejected under 35 USC §103(a) as being unpatentable over Yuval in view of US patent No. 6,215,875 to Nohda. These rejections are traversed.

As a preliminary matter, the Action at page 7 asserts that "'***' additionally qualifies as prior art under another subsection of 35 USC §102(e), and therefore, is not disqualified as prior art under 35 USC §103(a)(c)." If the reference indicated by "***" is Yuval, Applicant respectfully disagrees.

According to the MPEP § 2146, "[e]ffective November 29, 1999, 35 U.S.C. 103(c) provides that subject matter developed by another which qualifies as "prior art" only under one or more of subsections 35 U.S.C. 102(e), (f) and (g) is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103, provided the subject matter and the claimed invention were commonly owned at the time the invention was made." In view of this, **Yuval is not to be considered when determining whether claims 7, 8, 9, 11-15, 22, 23, 30 and 34 are obvious under 35 USC §103.**

Here, Yuval qualifies as prior art under 35 USC 102(e) (e.g., as applied by the Action in the claim rejections under 35 USC §102(e)). Yuval and the subject matter of the rejected claims were commonly owned or subject to assignment at the time the invention was made. Accordingly, Yuval is not to be considered when determining whether claims 7, 8, 9, 11-15, 22, 23, 30 and 34 are obvious under 35 USC §103.

Since Yuval is not a proper reference to reject claims 7, 8, 9, 11-15, 22, 23, 30 and 34 as obvious under 35 USC 103, Applicant will address these claim rejections over Nohda, as applied by the Action.

In addressing **claim 7**, the Action relies on Nodha for the teaching that a digital good includes video content. Applicant respectfully submits that these teachings by themselves still fail to respectively teach or suggest all of the respective features of claims 7, which depends from claim 1. This is especially true since Yuval is not to a proper reference for determining whether claim 7 is obvious for the reasons already discussed.

Withdrawal of the 35 USC §103(a) rejection to claim 7 is requested.

In addressing **claim 8**, the Action relies on Nodha for the teaching of Data Encryption Standard (DES) to assert that claim 8 is obvious. **However, claim 8 does not even include the feature of DES** – possibly the Action meant to use this rational with one or more of claims 15, 30, and/or 34, which do include the feature of DES.

Instead, claim 8 recites: "selecting a segment of a digital good", "selecting another segment of the digital good, wherein the other segment is to be encrypted using an encryption process", and "mapping, as at least part of the encryption process, values within the other segment to new values based on the segment, wherein the mapping comprises using the segment as a substitution box (S-box) during the encryption process." For the reasons already discussed, Yuval is not to a proper reference for determining whether claim 8 is obvious (Yuval is completely silent on these features anyway). The DES teaching of Nodha does not cure these deficiencies of this attempted combination. Accordingly, the Action has failed to present a prima facie case of obviousness of claim 8.

Withdrawal of this rejection of claim 8 is requested.

In addressing **claims 9, 11, 12, 13, 14, 15, 22, 23, 30, and 34,** the Action does not cite any portion of the secondary reference Nodha for any specific teaching to support these obviousness rejections. Instead, the Action only cites specific portion(s) of Yuval and then asserts that the combination teaches the claimed features. As a result, it is not particularly clear whether the Action is applying an anticipation standard or an obviousness standard in rejecting these claims. However, since these rejections are listed as 35 USC 103(a) rejections, Applicant addresses these rejections as obviousness rejections.

Claim 9 depends from claim 8. For the reasons already discussed, Yuval cannot be used to support him an obviousness rejection of claims 9 or 8. Nodha is not cited for any teaching in this rejection. Accordingly, the Action has failed to present a prima facie case of obviousness with respect to claim 9.

Withdrawal of the rejection of claim 9 is requested.

Claims 11-15 depend from claim 8. For the reasons already discussed, Yuval cannot be used to support him an obviousness rejection of claims 11-15 or 8. Nodha is not cited for any teaching in this rejection. Accordingly, the Action has failed to present a prima facie case of obviousness with respect to claims 11-15.

Withdrawal of the rejections of claims 11-15 is requested.

Claim 30 depends from claim 25. For the reasons already discussed, Yuval cannot be used to support him an obviousness rejection of claims 30 or 25. Nodha is relied on only for the teaching of DES. The teaching of DES does not cure the already discussed deficiencies of the cited combination with respect to the claimed

features. The result, the Action has failed to present a prima facie case of obviousness with respect to claim 30.

Withdrawal of the rejection of claim 30 is requested.

Claim 34 depends from claim 33. However, for the reasons already discussed above, Yuval cannot be used to reject claims 33 and/or 34 in an obviousness rejection. Moreover, for the reasons already discussed, Yuval does not disclose features of claim 33, upon which claim 34 depends. The only teaching of Nodha that the Action is relying on is the teaching of DES. The teaching of DES does not cure the already discussed deficiencies of the cited combination with respect to the claimed features.

Withdrawal of the rejection of claim 34 is requested.

<u>Claims 33-36 stand rejected under 35 USC §103(c) as being unpatentable over Yuval.</u>

Section 103(c) of 35 USC indicates that certain references are not to be considered when formulating obviousness rejections. Please see the MPEP §2146. It just so happens for the reasons already discussed that **Yuval is such a reference that cannot be used to reject claims 33-36 as being obvious.** Thus, the Action has failed to present a prima facie case of obviousness with respect to claims 33-36.

Withdrawal of the rejection of claims 33-36 is requested.

Conclusion

Pending claims 1-9, 11-16, 25-31, and 33-36 are in condition for allowance and action to that end is urgently requested. Should any issue remain that prevents

allowance of the application, the Office is encouraged to contact the undersigned prior or issuance of a subsequent Office Action.

Respectfully Submitted,

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